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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte CHIKAKO KARIYA

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Appeal 2009-000631
Application 09/938,485
Technology Center 2100

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Decided: February 25, 2010

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Before HOWARD B. BLANKENSHIP, DEBRA K. STEPHENS, and
JAMES R. HUGHES, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's

rejection of claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56, which are all

the claims remaining in the application. We have jurisdiction under 35

U.S.C. § 6(b).

We reverse.

Representative Claim

1.   A related documents processing device, associating relevance among at least separately created documents, comprising:

a detector detecting relevance among the separately created documents; and

a locator locating a timewise latest document related to a document selected based on detected relevance information,

wherein the documents are electronic mail (emails), and the relevance information detected by the detector includes an email exchange history of a branching of separate emails from a first email, with the branching of emails including at least two distinct time-wise non-sequential emails branching from the first email on a same branch of the branching of emails and/or at least two distinct time-wise sequential emails branching from the first email on different branches of the branching of emails.

Prior Art

Moody   5,890,177   Mar. 30, 1999

Microsoft Corp., *Getting Results with Microsoft Office 97*, pp. 365-94, 396-401 (1997) ("Office").

Examiner's Rejections

Claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody and Office.

DISCUSSION

Appellant's Contention

Appellant argues, *inter alia*, that the applied references do not demonstrate the obviousness of a "detector" and a "locator" as recited in claim 1 that use "relevance information" as specified in the "wherein" clause of the claim.

Claim Interpretation

Unfortunately, Appellant does not tell us where the "wherein" clause of claim 1 might be described (i.e., supported) in the Specification, beyond a mere reference to instant Figures 3 and 6. *See* App. Br. 8. *Cf.* 37 C.F.R. § 41.37(c)(1)(v)("*Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.").

We assume that Figure 6 must depict "an email exchange history of a branching of separate emails from a first email." The "first email" appears to refer to "Mail Document" 1. The "branching" of emails is claimed as including "at least two distinct time-wise *non-sequential* emails branching from the first email on a same branch of the branching of emails" and/or "at least two distinct time-wise *sequential* emails branching from the first email on different branches of the branching of emails" (emphasis added).

Figure 6 does not indicate what might be considered a "same branch" and what may be considered "different branches" of the "branching of emails." However, in view of the Specification (24:19 - 25:21), the claimed two "distinct time-wise sequential emails" may refer to Mail Document 4

and Mail Document 5. Two "distinct time-wise non-sequential emails" may refer to Mail Document 3 and Mail Document 7, which may be considered on a different "branch" from Mail Document 4 and Mail Document 5. In view of the Specification text bridging pages 24 and 25, a user selecting (clicking on) Mail Document 2 on a display device results in the display unit displaying "the contents of the latest mail document" to respond as Mail Document 6. If the user clicks on Mail Document 3, the display unit "displays the contents" of Mail Document 7 (i.e., the last document to respond to Mail Document 3, or the "timewise latest document" 7 "related to a document selected" 3 "based on detected relevance information" -- as claimed).

The claimed "relevance information" might also be considered to read on Figure 3, as Appellant contends in the Appeal Brief. The "and/or" language of claim 1 means that the "relevance information" might include no more than, for example, "two distinct time-wise sequential emails" (Mail Document 2 and Mail Document 3), although Appellant has not identified where each (or any) of the multiple "branches" of claim 1 are shown in Figure 3.

In any event, Appellant asserts that the "relevance information" as claimed means a relevance between separately created documents, with the information including an email exchange history of a "branching" of separate emails from a first email. App. Br. 10.

Claim Interpretation/The Rejection

In view of the position set out in the Answer, the Examiner appears to accept, in general, Appellant's statement of what claim 1 requires (that we

have reproduced *supra* from App. Br. 10), although disagreeing with
Appellant's view of what makes a document an "email" document.[1]
However, the rejection of claim 1 (Ans. 4) relies on Office for the
"branching of separate emails," and the reference clearly describes "emails"
consistent with Appellant's view of "emails." For purposes of this appeal,
we will therefore interpret claim 1 as requiring, at the least, locating "a
timewise latest document [email] related to a document [email] selected" --
or locating the latest email in a chain of related emails -- based on detected
"relevance information." The "relevance information" includes an email
exchange history that includes at least two emails that were produced later in
time than a reference ("first") email.

  The rejection of claim 1 (Ans. 4) submits that Moody teaches, in
material at columns 4 and 10, a timewise order of documents based on a
timestamp indicating when the document was created or edited. As
Appellant argues, however, Moody is directed to collaborative editing of a
document by an author providing editors with separate copies of the
authored document (*see, e.g.*, Moody Abstract; Figs. 2A, 3). The
"timestamp" taught by Moody is linked with a creator ID for the creator of
the document. The "timestamp" is used to determine if there is a time match
between the original document and the edited copy, thus to ensure that the
edited copy derived from the original document. *See* Moody col. 10, ll. 10-

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[1] The Examiner, improperly, refers to evidence in the Response to
Arguments section of the Answer (*e.g.*, Ans. 12-13) that is not contained in
the statement of the rejection. *Cf. In re Hoch*, 428 F.2d 1341, 1342 n.3
(CCPA 1970) ("Where a reference is relied on to support a rejection,
whether or not in a 'minor capacity,' there would appear to be no excuse for
not positively including the reference in the statement of rejection.").

34, and in particular lines 23-25: "If both the creator ID and the timestamp match for the original document and the edited copy, then the documents are checked for embedded objects." Moody thus teaches matching two documents based on an identical timestamp in the two documents. The rejection fails to demonstrate that Moody contains any teaching directed to temporal ordering of documents based on timestamps in the documents.

Moreover, an email document (as described by Office) was known to contain header information that identifies when the email was sent (i.e., its effective time of production). The timestamp taught by Moody appears to represent no more than what prior art email documents already contained. We agree with Appellant to the extent that the rejection fails to show how the combination of Moody and Office might be deemed to teach, or otherwise demonstrate the obviousness of, a method or system for locating a "timewise latest" email by means of an email exchange history that includes at least two emails that were produced later in time than a "selected" email.

Each of independent claims 20 and 39 contains language similar to that of claim 1, but are rejected on substantially the same basis as claim 1 over Moody and Office. Independent claims 11, 30, and 49 recite parsing and merging (email) documents that are determined to be related by detecting "relevance information," with the "relevance information" defined as in claim 1. Of claims 11, 30, and 49, the rejection treats claim 11 separately (Ans. 6-7) from claim 1, but fails to demonstrate that the prior art teaches, or otherwise renders obvious, determining that emails are related by detecting an email exchange history that includes at least two emails that were produced later in time than a reference ("first") email.

We therefore cannot sustain the § 103(a) rejection of any of the claims over Moody and Office.

DECISION

The rejection of claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 under 35 U.S.C. § 103(a) as being unpatentable over Moody and Office is reversed.

REVERSED

msc

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